

REMARKS

Upon entry of the amendments, claims 1-9 will be pending in the application. Applicants provide the following comments in reply to the Office Action of December 15, 2003.

Amendment

Upon careful consideration, Applicants have amended claim 1. New claims 8 and 9 have been added to the application. No new matter has been introduced. Applicants have enclosed the requisite fee for the extra independent claim.

Claim Rejections – 35 U.S.C. § 102

Claims 1-6 and 8 are rejected as anticipated by Mikuriya (US 5,849,453).

Applicants believe that this rejection should be withdrawn. Mikuriya uses the same toner as the initial toner and the replenishment toner (col. 17, lines 54 to 56). The present invention uses different toners as an initial toner and as a replenishment toner.

In Mikuriya, Applicants understand Table 1 as showing the particle size distribution of the initial and/or replenishment toner. On the other hand, Applicants understand that Table 2 of Mikuriya depicts the particle size distribution of a collected toner (not initial toner or replacement toner). Rather, Figs. 1 to 3 of Mikuriya demonstrate that the initial replenishment toner shown in Fig. 1 is mixed with the collected toner having the particle size distribution shown in Table 2. Then the mixture is fed to the developer unit. Applicants respectfully urge that it is improper hindsight to compare the toner particles in Mikuriya's collected toner, which is mixed with

Mikuriya's replenishment/initial toner, with the toner particles in the Applicant's replenishment toner. Applicants respectfully urge that the rejection over Mikuriya thus untenably is based upon hindsight, and therefore must be withdrawn.

Applicants note the Examiner's reference to a toner containing 2.6% of particles with a diameter of 5.04 μm or smaller in Mikuriya. However, Mikuriya's initial toner is also his replenishment toner. Therefore, the ratio of Mikuriya's initial toner to replenishment toner (in regard to the 5.04 μm particle size or less) is 1.0. This clearly is below Applicants' claimed ratio (1.5 to 3.5) set forth in independent claim 1 and independent claim 6. Hence Applicants' replenishment toner, according to the pending claims, is not inherently or explicitly disclosed by Mikuriya. The rejection should be withdrawn.

* * *

Claims 1-8 are rejected as being anticipated by Sano (US 5,863,694). Applicants respectfully request that this rejection be withdrawn.

Applicants understand that Sano discloses only one type of toner. As such, a person skilled in the art would expect to use this toner as both an initial toner and replenishment toner because Sano does not expressly state otherwise.

As to the claims, the ratio between the initial and replenishment toner in Sano thus would be 1.0 (the same toner), and must be outside the claimed range of 1.5 to 3.5 set forth in independent claim 1 and independent claim 6.

Double Patenting

Applicants note that the Office Action details a provisional double patenting rejection, which need not be addressed at this time.

New Claims

New claims 9 and 10 recite a system and method of use that involve an initial toner and replenishment toner having the claimed ratio of toner particles with a diameter of 5.04 μm or smaller. It is respectfully submitted that these claims are not anticipated or obvious in view of the cited prior art.

CONCLUSION

Applicants respectfully assert that the application should be allowed. If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

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Signature:



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